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10/581,261	07/11/2006	Sven Kornfalt	8688.049.USD000	1815
74217 7590 09/02/2011 NOVAK, DRUCE + QUIGG L.L.P. - PERGO 300 New Jersey Ave, NW Fifth Floor Washington, DC 20001				
EXAMINER				
OTHERN, BRENT T				
ART UNIT		PAPER NUMBER		
1783				
MAIL DATE		DELIVERY MODE		
09/02/2011		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/581,261

**Applicant(s)**

KORNFALT ET AL.

**Examiner**

BRENT O'HERN

**Art Unit**

1783

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 5) ☒ Claim(s) 1-20 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☒ Claim(s) 14-16 and 20 is/are allowed.
- 7) ☒ Claim(s) 1-13 and 17-19 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-800)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Claims***

1. Claims 1-20 are pending with claims 1-13 and 17-19 rejected and claims 14-16 and 20 allowed (if claims 16 and 20 are rewritten as independent claims) per the Board's decision mailed 8/30/2011. See the Board's decision for further guidance.

### **WITHDRAWN REJECTIONS**

2. All rejections of record in the Office action mailed 4/8/2009 that are deemed "Reversed" by the Board per the decision mailed 8/30/2011 are withdrawn.

### **REPEATED REJECTIONS**

3. All rejections of record in the Office action mailed 4/8/2009 that are deemed "Affirmed" by the Board per the decision mailed 8/30/2011 are repeated. The rejections are repeated below.

### ***Claim Rejections - 35 USC § 102***

4. Claims 1-2, 7 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Grau (WO 03/060256) with evidence by Grau (US 2005/0115181). Grau ('181) is the English equivalent to Grau ('256). Grau (US 2005/0115181) states on its' face that Grau (US 2005/0115181) is the national stage entry of PCT/FR03/00025 filed 1/7/2003. The international application number for Grau (WO 03/060256) is the same PCT/FR03/00025 with filing date of 1/7/2003. Grau (WO 03/060256) was published on 7/24/2003 which is before the Swedish filing date of 12/11/2003 of Applicant's application.

Art Unit: 1783

Grau ('256) teaches a flooring system comprising a plurality of panels (*See FIGs 2-3, 10-11 and 1, module #1 and tile #7.*)

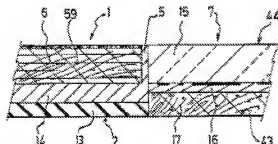


Fig 2

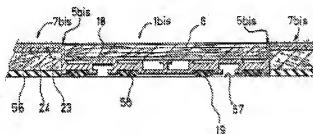
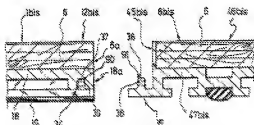
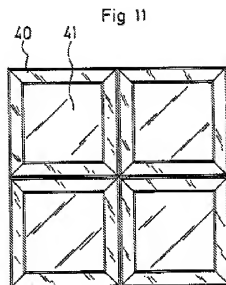


Fig 3

Fig 10





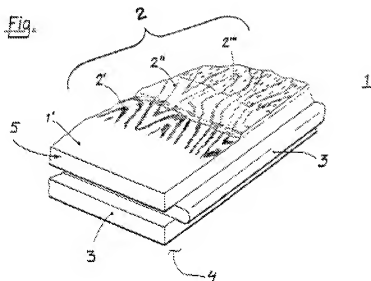
each panel/ (the panels) comprising a carrying panel provided with edges, the edges being provided with a snap-joining functionality, at least one panel differing in at least one of aesthetic or mechanical properties from another panel of the system, the carrying panels further being provided with an upper side and a lower side wherein the flooring system comprises a plurality of panels where each carrying panel is provided with an upper decorative surface on the upper side of the carrying panel with a surface structure and the flooring system comprises panels having at least two of the decorative surfaces being different from each other and independently consisting of a decorative material selected from a mineral, a mineral composite, a thermoplastic composite or a fabric (See FIGs 2-3, 10-11, 1 and paras. 61-72, 81-84, 8, 44 as illustrated in FIG-2 and the other figures, module #1, with decorative lamina #6, receptacle for receiving lamina #59, lower web #14, square tile #7, glass #15 and decorative sheet #16. Fig-3 illustrates tiles #7bis with carpet #23. The materials can be minerals and/or mineral composites such as the metals aluminum and steel and glass, thermoplastic PVC or carpet. The

*surfaces of the panels are made of different materials. Claim 1 does not require each panel to only have one decorative surface and not two or more decorative surfaces.*

*The claims do not require the materials of one surface to be different from that of another surface but rather for the system to have more than one panel and more than one surface. Two panels will have two physically different surfaces since they are different panels. FIG-10 illustrates the panels being joined by male and female members #35 and #34, respectively having a snap-joining functionality.).*

5. Claims 1, 4-6, 8-10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Hansson et al. (US 6,465,046).

Hansson ('046) teaches a flooring system comprising a plurality of panels, at least one panel differing in aesthetic properties from another panel of the system, with carrying panels having edges (See FIG-1, col. 6, l. 65 to col. 7, l. 11 and col. 10, ll. 15-28 where a decorative surface element such as a map extends over several panels, thus providing for different aesthetic properties on the different panels since each panel has a different portion of the map.),



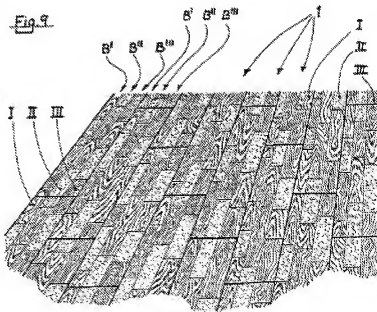
the edges being provided with means for joining (*See FIG-1, entire FIG where the panel has tongues and grooves at the edges for joining the panels.*), the carrying panel further being provided with an upper side and a lower side wherein the flooring system comprises a plurality of panels (*See FIG-1, panels having upper/lower sides.*) where each carrying panel is provided with an upper decorative surface on the upper side of the carrying panel and that the flooring system comprises panels having at least two of the decorative surfaces being different from each other and independently consisting of a decorative material including a thermosetting composite comprising cellulose and a radiation curing melamine-formaldehyde amino resin with hard particles such as aluminum oxide, silicon oxide and silicon carbide, the particles having an average particles size in the range 50 nm-150  $\mu\text{m}$  (*See FIG-1 and col. 5, ll. 5-10, 39-54, decorative surface #2. Claims 1 and 10 do not require each panel to only have one decorative surface and not two or more decorative surfaces. The claims do not require the materials of one surface to be different from that of another surface but rather for the*

*system to have more than one panel and more than one surface. Two panels will clearly have two physically different surfaces since they are different panels.).*

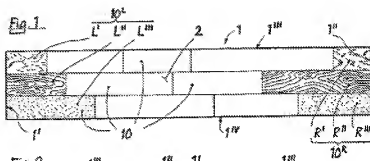
***Claim Rejections - 35 USC § 102/103***

6. Claims 1, 10 and 13 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sjoberg (US 2004/0170812).

Sjoberg ('812) teaches a flooring system comprising a plurality of panels with surface structures, each carrying panel with edges (See FIGs 9 and 1 where the panels with edges have different aesthetic appearances due to their surface structures I, II and III. Some of panels as illustrated in FIG-9 have five surface structures on a side while other panels have 4 panels on a side, thus, different appearances.).







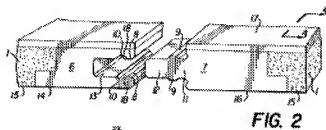
the carrying panel further being provided with an upper side and a lower side wherein the flooring system comprises a plurality of panels (*See FIGs 9 and 1 plurality of panels with upper and lower sides.*), where each panel is provided with an upper decorative surface with the appearance of wood and the flooring system comprises panels with at least two of the decorative surfaces being different from each other and independently consisting of a decorative material including a thermosetting composite (*See para. 7 and FIGs 9 and 1. Claims 1 and 10 do not require each panel to only have one decorative surface and not two or more decorative surfaces. The claims do not require the materials of one surface to be different from that of another surface but rather for the system to have more than one panel and more than one surface. Two panels will clearly have two physically different surfaces since they are different panels.*) and inherently teaches edges being provided with means for joining and the surface being glossy (*See FIGs 9 and 1 where the panels are joined by their edges having a means for joining and the surface is glossy.*).

In the alternative, a person having ordinary skill in the art would obviously appreciate or provide a means for joining the panels and glossy surface. Thus, a rejection under 35 USC 102/103 is proper (*See MPEP 2112.*).

**Claim Rejections - 35 USC § 103**

7. Claims 1-3, 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martensson (US 6,397,547) in view of Sjoberg (US 2004/0170812).

Regarding claims 1, Martensson ('547) teaches a flooring system comprising a plurality of panels with the carrying panels having edges (*See col. 3, ll. 31-42 and FIG-2, panel #1 with groove #6 and tongue #7.*), the edges being provided with means for joining (*See FIG-2, groove #10 and snapping web #9 for joining.*), the carrying panel further being provided with an upper side and a lower side (*See FIG-2, panels #1 and col. 2, ll. 30-63.*) where each panel is provided with an upper decorative surface and the flooring system comprises panels with at least two of the decorative surfaces being a thermoplastic composite or a thermoplastic foil, (*See col. 3, ll. 23-30 and FIG-2, #1.*),



however, fails to expressly disclose the panels being different and independently consisting of decorative material.

however, fails to expressly disclose the panels being different and independently consisting of decorative material.

However, Sjöberg ('812) teaches a flooring system comprising a plurality of panels with at least one panel being different (See FIGs 9 and 1 where the panels with edges have different appearances due to their surface structures I, II and III. Some of panels as illustrated in FIG-9 have five surface structures on a side while other panels

*have 4 panels on a side, thus, different appearances. Claims 1 and 10 do not require each panel to only have one decorative surface and not two or more decorative surfaces. The claims do not require the materials of one surface to be different from that of another surface but rather for the system to have more than one panel and more than one surface. Two panels will clearly have two physically different surfaces since they are different panels.)* for the purpose of providing panels with the desired décor or pattern (*See para. 3.*).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to provide different panels as taught by Sjöberg ('812) in Martensson ('547) in order to provide panels with the desired décor or pattern.

Regarding claim 2, Martensson ('547) teaches where the edges are provided with snap-joining functionality (*See FIG-2, groove #10 and snapping web #9.*).

Regarding claim 3, Martensson ('547) teaches where the edges are provided with pre-applied glue (*See col. 2, ll. 43-47 and col. 4, ll. 6-11.*).

Regarding claim 7, Martensson ('547) teaches where the thermoplastic composite comprises thermoplastic materials selected being polyvinyl chloride or polyethylene (*See col. 3, ll. 23-27.*).

Regarding claim 11, Martensson ('547) teaches where the thermoplastic foil is polyvinyl chloride, polyethylene or polypropylene (*See col. 3, ll. 23-27.*).

8. Claims 4-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grau (WO 03/060256) with evidence by Grau (US 2005/0115181) in view of Hansson et al. (US 6,465,046).

Grau ('256) teaches the flooring system discussed above, however, fails to expressly disclose at least two of the decorative surfaces being a thermosetting composite comprising cellulose and a radiation curing melamine-formaldehyde amino resin with hard particles such as aluminum oxide, silicon oxide and silicon carbide, the particles having an average particles size in the range 50 nm-150  $\mu$ m, thermoplastic materials such as PVC, polyolefins and other polymers, polymeric and metal foils.

However, Hansson ('046) teaches flooring panels where at least two of the decorative surfaces are a thermosetting composite comprising cellulose and a radiation curing melamine-formaldehyde amino resin with hard particles such as aluminum oxide, silicon oxide and silicon carbide, the particles having an average particles size in the range 50 nm-150  $\mu$ m (*See FIG-1 and col. 5, ll. 5-10, 39-54, decorative surface #2.*) for the purpose of providing a stable, strong, abrasion resistant decorative panel (*See col. 7, ll. 12-15 and Abstract.*). Furthermore, selecting one of the above polymeric or metal materials for the panel surfaces would have been obvious depending on whether the panels are used outdoors, indoors, subject to heavy traffic, no traffic, consumer preference based on appearance or cost.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to provide Grau's ('256) mixed flooring having panels with the above materials as taught by Hansson ('046) and the other

polymeric/metal materials in order to provide a stable, strong, abrasion resistant decorative panel.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grau (WO 03/060256) with evidence by Grau (US 2005/0115181).

Grau ('256) teaches the panels discussed above made of carpet, however, fails to expressly disclose the carpet being a needle loom carpet.

However, a person having ordinary skill in the art at the time Applicant's invention was made would know that there are many different types of carpet, with people having different preferences, which are functionally equivalent to each other including loom carpet. Thus, it is a matter of design choice and personal preference to select one type of carpet over another. Furthermore, Applicant has not set forth any criticality of using one type of carpet over another. Therefore, it would have been obvious to substitute Grau's ('181) generic carpet by needle loom carpet in order to provide a carpet that is aesthetically pleasing to the user.

10. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sjoberg (US 2004/0170812) in view of Bettinger (US 3,811,237).

Regarding claim 17, Sjoberg ('812) teaches the system discussed above, however, fails to expressly disclose where the fabric comprises a needle loom carpet.

However, Bettinger ('237) teaches that floor panels made of carpet and other materials such as vinyl are known (*See col. 4, ll. 33-61 and FIGS 4A, 10 and 1, panels #20. Furthermore, a needle loom carpet and Bettinger's ('237) carpet are interpreted as being interchangeable as Applicant has not presented any criticality of using one carpet*

*over another.*) for the purpose of providing a flexible, resilient walking surface for an easily accessible, expandable flooring (*See col. 1, ll. 16-35.*). Furthermore, it was known at the time Applicant's invention was made that in office environments people have a preference for flooring surfaces that are carpeted in some regions and smooth in the immediate vicinity of the desk chair so as allow for easy movement of a desk chair, especially one that has rollers.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to provide floor panels with carpet as taught by Bettinger ('237) in Sjöberg ('812) in order to provide a flexible, resilient flooring that can easily be used in combination with other flooring materials.

Regarding claim 18, Sjöberg ('812) teaches a floor comprising a thermosetting composite (*See para. 7 and FIGs 9 and 1.*), however, fails to expressly disclose said materials being incorporated into the surface of the panels. However, it would it would have been obvious to incorporate said materials into the surface depending on how the flooring it used, whether the use is indoor, outdoor, high traffic, etc.

11. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sjöberg (US 2004/0170812) in view of Bettinger (US 3,811,237) and Martensson (US 6,397,547).

Sjöberg ('812) and Bettinger ('237) teach the system discussed above, however, fail to expressly disclose where the floor comprises a thermoplastic foil.

However, Martensson ('547) teaches a flooring comprising a thermoplastic foil (*See col. 3, ll. 23-27.*) for the purpose of providing a flooring that does not absorb water (*See col.3, ll. 28-30.*).

Therefore, it would have been obvious to provide a flooring made of thermoplastic foil as taught by Martensson ('547) in Sjöberg ('812) in order to provide a flooring that does not absorb water.

**12.** Claims 1 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sjöberg et al. (WO 02/47906) in view of Sjöberg (US 2004/0170812).

Sjöberg ('906) teaches a flooring system with a plurality of panels comprising a carrying panel with edges (*See p. 1, ll. 16-25 floor laminate with edges.*), the edges being provided with means for joining (*See p. 1, ll. 16-25 wherein the panel clearly has edges and all edges can clearly be joined.*), the carrying panel further being provided with an upper side and a lower side (*See p. 1, ll. 16-25 wherein the plurality of panels have upper/lower sides.*), where each panel is provided with an upper decorative surface on the upper side of the panel and the flooring system comprises panels having at least two of the decorative surfaces being a thermoplastic composite or a thermoplastic foil and different (*See p. 2, ll. 15-22, where the foil is above the core.*), however, fails to expressly disclose the surfaces being different independently consisting of a decorative material.

However, Sjöberg ('812) teaches a flooring system comprising a plurality of panels with at least one panel differing from one another (*See FIGs 9 and 1 where the panels with edges have different aesthetic appearances due to their surface structures*

*I, II and III. Some of panels as illustrated in FIG-9 have five surface structures on a side while other panels have 4 panels on a side, thus, different appearances. Claims 1 and 10 do not require each panel to only have one decorative surface and not two or more decorative surfaces. The claims do not require the materials of one surface to be different from that of another surface but rather for the system to have more than one panel and more than one surface. Two panels will clearly have two physically different surfaces since they are different panels.) for the purpose of providing panels with the desired décor or pattern (See para. 3.).*

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to provide different panels as taught by Sjoberg ('812) in Sjoberg ('906) in order to provide panels with the desired décor or pattern.

### **ANSWERS TO APPLICANT'S ARGUMENTS**

**13.** Further arguments supporting the above rejections can be viewed in the Board's decision mailed 8/30/2011.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRENT O'HERN whose telephone number is (571)272-6385. The examiner can normally be reached on Monday-Thursday, 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BRENT O'HERN/  
Primary Examiner, Art Unit 1783  
August 30, 2011